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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE J. MURAKAWA, R. BRUCE WALLACE,
JOHN A. ZAIA and JOHN J. ROSSI

Appeal 2010-012299
Application 07/402,450
Technology Center 1600

Before SALLY G. LANE, ERIC GRIMES, and STEPHEN WALSH,
Administrative Patent Judges.

GRIMES, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appellants request rehearing of the decision entered July 13, 2011 (“Decision”), which reversed the rejection on appeal and entered two new grounds of rejection. Appellants argue that both of the new rejections are improper because of the proceedings of Interference 105,055. We are not persuaded that Appellants’ arguments show either of the new grounds of rejection to be improper, although the arguments do highlight an error in our

reasoning. The request for rehearing is denied but we designate the denial as a new ground of rejection.

The Decision reversed the Examiner's rejection based on 35 U.S.C. § 135(b)(1) (Decision 3-4), and entered two new grounds of rejection: one for interference estoppel based on *In re Deckler*, 977 F.2d 1449 (Fed. Cir. 1992), and *In re Kroekel*, 803 F.2d 705 (Fed. Cir. 1986) (Decision 5-13), and one for interference estoppel based on 37 C.F.R. § 1.658(c) (Decision 13-15).

With respect to the rejection based on the reasoning of *Deckler* and *Kroekel*, Appellants argue that the Board in Interference 105,055 held that a claim including a "same or different" primer limitation was patentably distinct from Wang's claims. Specifically, Appellants argue that, during the interference, they submitted proposed claim 50, which required the use of a reference sequence that the "Interference Board characterized . . . as 'a synthetic RNA sequence selected from one of two genera, i.e., a reference sequence which does not include the target sequence or a reference sequence which includes substantially more nucleotides than the target sequence'" (Req. Rhg. 4).

Appellants note that the Interference Board determined that Murakawa claim 50 defined a genus of reference sequences that did not anticipate or make obvious the "same primers" species required by Wang (*id.* at 5). Appellants submit that "[s]ince Wang's claim was patentably distinct over Murakawa proposed claim 50, . . . the Interference Board found that Murakawa proposed claim 50 was patentably distinct from the Wang claim" (*id.*). Appellants argue that the claims on appeal are also patentably

distinct from Wang's claim because "the relevant parts of Murakawa proposed claim 50 and the instant claims on appeal describe the same element, namely the use of same or different oligonucleotides, *i.e.*, primer pairs, to simultaneously amplify a target sequence and a reference sequence" (*id.*, footnote omitted).

This argument is not persuasive. As the Board in Interference 105,055 stated, "[i]n order for there to be an interference-in-fact between claims, two way anticipation or obviousness must be established" (Interference 105,055 Decision on Murakawa Preliminary Motion 1 (Paper 47), page 7). That is, an interference-in-fact would require Wang's claim 1 to anticipate or make obvious Murakawa's proposed claim 50 *and* Murakawa's proposed claim 50 to anticipate or make obvious Wang's claim 1, assuming each was prior art to the other (*see id.*). The Interference Board held that Murakawa's proposed claim 50 did not anticipate Wang's claim 1 (*id.* at 15-23) nor did it make obvious Wang's claim 1 when combined with the prior art (*id.* at 23-29).

The Interference Board did not hold that the converse was true: that Murakawa's proposed claim 50 was patentably distinct from (*i.e.*, not anticipated by or obvious based on) Wang's claim 1. In fact, Appellants argued in their motion that proposed claim 50 would be anticipated by Wang claim 1, assuming Wang's claim was prior art (Interference 105,055, Murakawa Preliminary Motion 1 (Paper 38), page 18). Although Wang argued that Murakawa's proposed claim 50 included a Southern blotting step that was not a part of Wang's claim 1 (Interference 105,055, Wang Opposition 1 (Paper 44), pages 16-17), the Interference Board held that this

technique was “such an old and well-known” method (Interference 105,055, Paper 47, page 14) that reciting it expressly was not a patentable distinction (*id.* at 15).

Thus, the Board in Interference 105,055 held that the “same primers” species of Wang’s claim 1 was not anticipated by or made obvious by the genus of primers recited in Murakawa claim 50. It did not hold, as Appellants allege, that the genus of primers recited in Murakawa claim 50 was not anticipated or made obvious by the species of primers recited in Wang’s claim 1. The holding in Interference 105,055 does not preclude the new ground of rejection.

With regard to the new ground of rejection based on 37 C.F.R. § 1.658(c), Appellants argue that estoppel under this rule does not apply (Req. Rhg. 8) because “[b]y determining that the earlier Murakawa generic claims encompassing use of shared primer pairs or different primer pairs were patentably distinct from the count, the Interference Board effectively prevented Murakawa from adding the generic claims to the count and obtaining a judgment on the generic claims” (*id.* at 9). Appellants also argue that they did present subject matter similar to that of the rejected claims during the interference, specifically proposed claim 50, which shares with the claims on appeal the limitation of using either the same or different primer pairs to amplify the target and reference sequences (Req. Rhg. 11).

These arguments, while responsive to the reasoning set out in the Decision, do not persuade us that estoppel under 37 C.F.R. § 1.658(c) should not apply in this case. However, since our reasoning on reconsideration

differs somewhat from the reasoning in the Decision, we designate this a new ground of rejection.

Specifically, the estoppel issue does not depend on whether Appellants presented broader *claims* during the interference, but on whether they moved (or requested to move) to broaden the *count* to encompass the “same or different” primer pair limitation that they now seek to claim. Under Rule 658(c), a judgment in an interference settles all issues that were, or properly could have been, raised and decided in the interference. *See* 37 C.F.R. § 1.658(c). Such issues include a “motion to redefine the interfering subject matter by . . . adding or substituting a count.” 37 C.F.R. § 1.633.

Thus, Appellants could have moved, or sought to move, during Interference 105,055 to add or substitute a broader count – one that included the “same or different” primers limitation of the claims on appeal – for the count in the interference. Whether Appellants were the first to invent the method now claimed is therefore an issue that could have properly been raised and decided during the interference. Because Appellants failed to raise that issue during the interference, they are estopped from now obtaining *ex parte* claims to the broader subject matter that could have been put in issue *inter partes* during the interference.

The relevant facts of this case are similar to those of *In re Kroekel*, 803 F.2d 705 (Fed. Cir. 1986), which involved an interference between Kroekel and Comstock. *Id.* at 706. “Kroekel never moved to substitute a broader count.” *Id.* at 707. The Board awarded priority to Comstock, and Kroekel continued *ex parte* prosecution of his application and amended his

claim to make it “‘generic’ and ‘dominating’ with respect to the lost phantom count.” *Id.*

The amended claims were rejected and the Board affirmed: “The board noted the general rule that ‘a losing party in an interference proceeding *ordinarily* cannot be awarded claims broader than the interference issue and thus have claims which dominate the claims awarded to the successful party.’” *Id.* at 708. “The board held that Kroekel should have moved during the interference proceeding to broaden the count and thereupon have presented his best proofs.” *Id.*

The Court of Appeals for the Federal Circuit affirmed the rejection, holding that Kroekel’s “[c]laim 40 does not exclude the precise subject matter lost in the interference. To allow Kroekel that claim, via Rule 131 affidavits or otherwise, would be to permit an undeserving Kroekel to circumvent the adverse priority determination in the interference at the expense of the winning party, Comstock.” *Id.* at 710-711.

In this case, as in *Kroekel*, Appellants did not move to broaden the count but, after losing the interference, prosecuted claims ex parte that are generic to the count of the interference. As in *Kroekel*, Appellants should have moved, or sought to move, during the interference to broaden the count and thereupon presented their best proofs. *See Kroekel*, 803 F.2d at 710 (“If Kroekel *had* attempted to broaden the count and the PTO had prevented him from doing so, he would not be estopped from later claiming the broader subject matter.”).

Because Appellants could have tried to broaden the count in Interference 105,055 to include the “same or different” primers limitation,

but did not, they are “estopped to take ex parte or inter partes action in the Patent and Trademark Office after the interference which is inconsistent with [their] failure to properly move.” 37 C.F.R. § 1.658(c). Appellants are therefore estopped from claiming the subject matter of claims 190, 199, 208, 217, and 249-255 because that action is inconsistent with their failure to move to include that subject matter in the count of the interference.

SUMMARY

We deny Appellants’ request for rehearing with respect to both grounds of rejection that were set out in the Decision. Since our reasoning with respect to the rejection based on 37 C.F.R. § 1.658(c) differs from our previous reasoning, we designate the denial of rehearing a new ground of rejection in order to provide Appellants with a fair opportunity to respond. Appellants’ options for responding (below) apply to both new grounds of rejection set out in the Decision.

TIME PERIOD FOR RESPONSE

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

REHEARING DENIED; 37 C.F.R. § 41.50(b)

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